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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

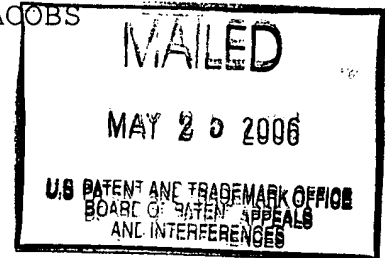
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC HORVITZ, ANDREW W. JACOBS

Appeal No. 2006-1291
Application No. 09/364,522

HEARD: MARCH 09, 2006



Before THOMAS, RUGGIERO and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-43.

Invention

Appellants' invention relates to a method, system, and machine-readable medium for receiving a document and assigning a measure of priority to the document based on a trained document classifier. Additionally, a determination is made of whether the user receiving the document is busy. Appellants' specification at page 2, lines 20-21, and page 22, lines 1-5.

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Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A computer-implemented method comprising:

receiving a document;

generating a priority of the document based on a trained document classifier;

determining whether a user is busy; and

alerting the user to the document based on a predetermined criteria.

References

The references relied on by the Examiner are as follows¹:

| | | |
|------------------------------|-----------|------------------------|
| Doi | 5,077,668 | Dec. 31, 1991 |
| Henderson et al. (Henderson) | 6,185,603 | Feb. 06, 2001 |
| | | (Filed March 13, 1997) |
| Platt | 6,327,581 | Apr. 04, 2001 |
| | | (Filed April 6, 1998) |

Forsher, Stewart, "CyberNag (Mailmen Division) Project Notebook" 02/21/1996, Available: http://www.cc.gatech.edu/computting/classes/cs3302_96_winter/projects/groups/MailMen.

Cohen, "Learning Rules that Classify E-mail", 1996 (as disclosed at <http://www.2cs.cmu.edu/~wcohen/pubs-t.html>).

Lewis, "Evaluating and Optimizing Autonomous Text Classification Systems", 1995 ACM.

Rejections At Issue

Claims 1-3, 8-12, 19-28, 32-34, 37, and 41-43 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Forscher, Cohen and Lewis.

Claims 4-7, 29, and 38-40 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Forscher, Cohen, Lewis and Henderson.

¹ The Examiner failed to list at page 2 of the answer the U.S. patents relied on as evidence.

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Claims 15, 17, and 18 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Forscher, Cohen, Lewis, Platt and Lewis².

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.³

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1-43 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming

² The Examiner cites the same Lewis reference twice in the rejection of claims 15, 17, and 18.

³ Appellants filed an appeal brief on September 26, 2005. Appellants filed a reply brief on January 26, 2006. The Examiner mailed an Examiner's Answer on November 29, 2005.

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forward with evidence or argument shift to the Appellants.

Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1 (representative of claims 2-43), Appellants argue at page 5 of the brief, "independent claim 1 (and similar independent claims [13,] 19 and 26) recites **determining whether a user is busy**." And "Forscher, Cohen, and Lewis, alone or in combination, do not teach or suggest such aspect of the invention as claimed." We agree.

The Examiner, at pages 19-20 of the answer, addresses Appellants' argument by repeating the statement of the rejection at pages 5-6 of the answer. In effect, the Examiner has not responded to Appellants' argument. We have reviewed the Lewis reference relied on by the Examiner and do not find a teaching of "determining whether a user is busy" at column 2 of page 246. While "determining whether a user is busy" and "alerting the

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user" is old and well known in the communication art (e.g., telephones), we find no analogous teaching in the email handling references relied on by the Examiner.


Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 1-43.

Conclusion


In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 1-43.

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REVERSED


JAMES D. THOMAS
Administrative Patent Judge

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge


ALLEN R. MACDONALD
Administrative Patent Judge

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